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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/586,038

12/15/2006

Josef Schneider

407PUS

9342

27799

7590

03/05/2009

COHEN, PONTANI, LIEBERMAN & PAVANE LLP  
551 FIFTH AVENUE  
SUITE 1210  
NEW YORK, NY 10176

EXAMINER

CHEN, YUAN L

ART UNIT

PAPER NUMBER

2854

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/586,038	<b>Applicant(s)</b> SCHNEIDER ET AL.	
	<b>Examiner</b> Yuan L. Chen	<b>Art Unit</b> 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) 19-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/13/2006</u> .                                               | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group II (Claims 32 – 36) in the reply filed on 1/16/2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 36 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The subject matter is “an open-loop or closed-loop control unit” in lines 1 – 2. The specification fails to particularly point out what is “an open-loop or closed-loop control unit” and what structure each of the “an open-loop control unit” and “a closed-loop control unit” is pertained to so as to be enabling.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 32 - 34 and 36 are rejected under 35 U.S.C. 102(b) as being anticipated by Shibuya et al. (Patent No.: US 5906156).

With respect to Claim 32, Shibuya et al. disclose in Figs. 1 and 4 as well as column 6 lines 10 – 23 and 40 - 44: a device for printing on a substrate, the device comprising:

at least one printing unit (17) for printing a static or unchanging image (L) on the substrate (R), and

at least one printing device (30), installed inline with the at least one printing unit (17), for individualizing the static image (L) by adding at least one dynamic or changing image (8 rotated by 90 degree) to the substrate (R).

With respect to Claim 33, Shibuya et al. disclose in Figs. 1 and 4 as well as column 4 lines 10 – 23: the at least one printing unit (17) used to print the static or unchanging image (L) is one of an offset printing unit, a gravure printing unit, or a flexographic printing unit.

With respect to Claim 34, Shibuya et al. disclose in Figs. 1 and 4 as well as column 6 lines 45 - 49: the device of claim 32, wherein the at least one printing device

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(30) used to print the at least one dynamic or changing image (8 rotated by 90 degree) is an ink-jet printing device.

With respect to Claim 36, Shibuya et al. disclose in Figs. 1 and 4 as well as column 6 lines 45 - 49: the device of claim 32, further comprising an open-loop (36) or closed-loop control unit, which manually or automatically controls the at least one printing unit (17) used to print the static or unchanging image (L) and the at least one printing device (30) used to print the at least one dynamic or changing image (8 rotated by 90 degree) to guarantee an integrated data (50 and 31 – 33) flow.

6. Claims 32 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Harrod et al. (Patent No.: US 6035782).

With respect to Claim 32, Harrod et al. teach in Fig. 1 as well as column 3 lines 11 - 21 and lines 38 - 43: a device for printing on a substrate, the device comprising:

at least one printing unit (14) for printing a static or unchanging (non-variable) image on the substrate (12), and

at least one printing device (10), installed inline with the at least one printing unit (14), for individualizing the static (non-variable) image by adding at least one dynamic or changing (variable) image to the substrate (12).

With respect to Claim 35, Harrod et al. teach in Fig. 1 as well as column 3 lines 11 - 21 and lines 38 - 43: the at least one printing device (10) used to print at least one the dynamic or changing (variable) image is based on the principle of electrophotography, magnetography, electrocoagulation, or ionography (ion deposition print unit 10).

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yuan L. Chen whose telephone number is 571-270-3799. The examiner can normally be reached on Monday-Friday 7:30 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached on 571-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/yc/

/Ren L Yan/  
Primary Examiner, Art Unit 2854